

Rejection Under 35 USC 112

Claim 15 is rejected under 35 USC 112 second paragraph as being incomplete for failing to recite at least one step. Applicants respectfully traverse. Claim 15 as written claims a method of stabilizing oxide and metallic etch rates for the specified composition by adjusting the pH to greater than 7.0 to about 11.0 and adding a buffer. "Adjusting" and "adding" are verbs that require an action. As such they define a step or steps when taken together. Applicants submit that, as such, the claim recites at least one step and therefore fulfills the stated requirement of 35 USC 112, second paragraph. Withdrawal of the rejection of claim 15 under 35 USC 112 is requested.

Rejection Under 35 USC 102(b)

Claims 1-15 are rejected under 35 USC 102(b) as being anticipated by Tanabe et al. (US 5,905,063). Applicants respectfully traverse the rejection.

Tanabe teaches a remover solution having a pH of 5 to 8 comprising

- a) 0.2 to 8 wt % of a salt of a hydrofluoric acid and a metal free base
- b) 30 to 90 wt % of a water soluble organic solvent selected from the group consisting of dimethyl sulfoxide, 1,3-dimethyl-2-imidezolidinone and diethylene glycol monobutyl ether, and
- c) the balance water

In addition, the composition can contain a corrosion inhibitor. In contrast to the presently claimed invention, the Tanabe reference fails to teach the presence of a buffer.

Anticipation requires that every element of a claimed invention be either expressly described or present under principles of inherency in a single prior art reference. Kalman v. Kimberly Clark Corp., 218 USPQ 781, 789 (Fed. Cir. 1983). When a claimed invention is not identically disclosed and instead requires picking and choosing among a number of different options disclosed by the reference, then the reference does not anticipate. Mendenhall v. Astec

Industries, Inc., 13 USPQ 2d 1913, 1928 (Tenn. 1988), aff'd 13 USPQ 2d 1956 (Fed. Cir. 1989).

"Buffer" is a term of art recognized by those skilled in the art as pertaining to compositions capable of neutralizing both acids and bases. Descriptions of buffers are enclosed herewith and include, Chemistry: A Conceptual Approach 2nd Ed., pp 561-564; and Encyclopedia of Chemical Technology vol. 7, pp 712-714. Applicants' claimed invention requires the presence of a buffer as it is understood by one skilled in the art.


The buffer performs a function. It helps to maintain the pH of the composition in which it is present. Applicants demonstrate in Figure 1 what happens to a composition comprising the salt of hydrofluoric acid and a metal-free base, a water soluble organic solvent and water (as claimed by Tanabe) when the composition is exposed to air. The composition absorbs carbon dioxide and the pH drops. Figure 2 illustrates the effects of a buffer on a similar system as claimed in the present invention.

The reference provides no disclosure that teaches a combination of components sufficient to act as a buffer. This Office Action lists various claims and possible components but makes no statement as to their relevance. Speculation as to whether any given combination of components might constitute a buffered system does not support anticipation.

"Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Ex parte Skinner, 2 USPQ 2d 1788 (B.P.A.I. 1986).

In view of the shortcomings of the cited reference, Applicants request withdrawal of the rejection of claims 1-15 under 35 USC 102(b).

Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that this Response is being deposited with the United States Postal Service on June 6, 2003 with sufficient postage as first class mail in an envelope addressed to the Commissioner for Patents, P. O. Box 1450, Alexandria, VA. 22313-1450.

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